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### REMARKS

Applicants respectfully request reconsideration. Claims 1-34 were previously pending in this application. By this amendment, Applicants are canceling non-elected claims 31-33 without prejudice or disclaimer. Applicants reserve the right to file one or more continuation or divisional applications directed to the canceled subject matter. Claims 1, 8, 13, 23, 26 and 34 have been amended. New claims 35 and 36 have been added. As a result, claims 1-30, and 34-36 are pending for examination with claims 1, 8, 13, 23, 26, 34, and 35 being independent claims. No new matter has been added.

#### *Allowable Subject Matter*

Applicants gratefully acknowledge the Examiner's finding that claims 8-12, 15-19, and 22-27 would be allowable if rewritten in independent form including all of the limitations of their base claims and any intervening claims. Claims 8, 23 and 26 have been rewritten in independent form. Claim 8 was also amended to remove the term "cut". Claims 9-12, 16, 17, 19, 24, and 25 have not been written in independent form, but each depends from one of the above independent claims and should be in condition for allowance for at least the same reasons. Claims 15, 18, 22, and 27 have not been rewritten into independent form, but each depends on independent claim 13, which is believed to be allowable for the reasons discussed below.

#### *Rejections Under 35 U.S.C. §102*

In the Office Action dated June 23, 2005, claims 1, 2, 6, 7, 13, 14, 20, 21, 28, 29, 30, and 34 were rejected under 35 U.S.C. §102(b) as being anticipated by Kendall (U.S. Patent No. 6,601,132), and claims 1, 2, and 4 were also rejected under 35 U.S.C. §102(b) as being anticipated by Lin (U.S. Patent No. 4,594,799). Applicants have amended independent claims 1, 13, and 34 to more clearly distinguish over both Kendall and Lin.

As amended, independent claim 1 recites a midsole insert for a shoe including a body having a heel portion, a midfoot portion, and a forefoot portion. The insert further includes a plurality of *energy return* grid systems located on the midsole insert, and each *energy return* grid system includes a plurality of openings *through* the midsole insert, forming a lattice pattern. The midsole insert is constructed and arranged to attach directly to an upper during a manufacturing step, to secure the shape of the upper on a last.

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Kendall is directed to a sole construction for shoes which includes a hammock-like lattice for support and control. The hammock-like structure substantially conforms to the foot such that the foot is suspended above the base of the shoe. Kendall states that by suspending the foot, portions of the foot are largely protected from the shock which is transmitted upwardly from the ground during gait. (Kendall, Col. 2, lines 27-29).

Kendall does not teach or suggest a plurality of *energy return* grid systems, as recited in amended claim 1. Kendall states that energy return and/or cushioning means, such as, respectively an air bladder or polyurethane foam pad, may be incorporated into the interior base of the shoe to contact the underside of the lattice at one or more strike points along the foot, or are incorporated within the lattice itself at such point. (Kendall, Col. 3, lines 21-27). Although Kendall states that energy return means may be used with the hammock-like lattice, Kendall does not disclose that the lattice itself is an energy return system. In the "Related Art" section, Kendall teaches away from the use of an energy return system. In this section, Kendall describes energy return systems, but states that such designs may cause the foot to become unstable, and may also lead to foot fatigue because the foot would absorb and deflect a significant amount of force generated during gait. Thus, claim 1 patentably distinguishes over Kendall, such that the rejection under §102 should be withdrawn.

Claims 2, 6, and 7 depend from claim 1 and are patentable in view of Kendall for at least the same reasons.

Lin is directed to a tennis shoe having an outsole 12 which includes both an upper layer 16 and a lower layer 18. The outsole 12 secures to a shoe upper 14 along the top surface of the upper outsole layer 16. The shoe upper 14 may also be stitched along the periphery of the outsole. Lin states that the upper portion of the upper outsole layer 16 includes a lattice or bridge 22 which has a plurality of diamond shaped recesses separated by intersecting raised ridges 24. However, the recesses of the bridge 22 do not extend completely through the layer 16. (Lin, Col. 2, lines 57-62).

Lin, therefore, does not teach or suggest a plurality of grid systems where each grid system includes a plurality of openings *through* the midsole insert, as recited in amended claim 1. Applicants amended claim 1 to further clarify that the plurality of openings do not just partially extend into the insert, but rather the openings extend *through* the insert. As mentioned above, Lin teaches that the recesses which form the bridge structure only partially extend

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through layer 16. Thus, claim 1 patentably distinguishes over Lin, such that the rejection under §102 should be withdrawn.

Claims 2 and 4 depend from claim 1 and are patentable in view of Lin for at least the same reasons.

Now turning to amended independent claim 13, which is directed to a midsole insert for a shoe. Claim 13 recites a body having a heel portion, a midfoot portion, and a forefoot portion, with a first *energy return* grid system located on the heel portion, and a second *energy return* grid system located on the forefoot portion. Each *energy return* grid system includes a plurality of openings which form a lattice pattern, and the midsole insert is formed of at least two materials having different hardnesses, such that a majority of the heel portion has a greater hardness than the forefoot portion.

As discussed above, Kendall does not teach or suggest energy return grid systems, as recited in amended claim 13. Applicants amended claim 13 to clarify that the claimed grid systems are not intended to cover a hammock-like structure similar to the arrangement taught in Kendall. Thus, claim 13 patentably distinguishes over Kendall, such that the rejection under §102 should be withdrawn.

Claims 14, 20, 21, 28, 29, and 30 depend from claim 13 and are patentable in view of Kendall for at least the same reasons.

Finally, amended independent claim 34 is directed to a shoe including a textile and synthetic upper, and a midsole insert having a heel portion, a midfoot portion, and a forefoot portion. The midsole insert is attached directly to the upper. At least part of the forefoot portion is made of a first material and at least part of both the heel and midfoot portions are made of a second material, and the stiffness of the first material is less than the stiffness of the second material. The shoe further includes an outsole attached to the underside of the midsole insert, and a sock lining inserted into the shoe positioned directly on the topside of the midsole insert. The midsole insert further includes a plurality of *energy return* grid systems located on the midsole insert, and each *energy return* grid system includes a plurality of openings forming a lattice pattern on the midsole insert.

Applicants amended claim 34 to further clarify that the claimed grid systems are *energy return* systems. Because Kendall does not teach or suggest the use of an energy return grid

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system, claim 34 patentably distinguishes over Kendall, such that the rejection under §102 should be withdrawn.

### ***Rejections Under 35 U.S.C. §103***

In the Office Action, claims 3-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kendall.

Without acceding to the propriety of this rejection, claims 3-5 depend from independent claim 1 and are patentable for at least the same reasons set forth above. Accordingly, the rejection of these claims over Kendall should be withdrawn.

### ***New Claims***

Applicants have added new claims 35 and 36, including independent claim 35 to further define the invention. Support for the new claims may be found at least in the figures of the application.

New independent claim 35 is directed to a midsole insert for a shoe. The midsole insert includes a body having a heel portion, a midfoot portion, and a forefoot portion, and a plurality of grid systems located on the midsole insert. Each grid system includes a plurality of openings through the midsole insert, forming a lattice pattern. The midsole insert is constructed and arranged to attach directly to an upper during a manufacturing step, to secure the shape of the upper on a last. *The plurality of grid systems includes at least a first grid system and a second grid system, and at least said first grid system is discrete from said second grid system.*

Both Kendall and Lin fail to teach or suggest a midsole insert constructed and arranged to attach directly to an upper during a manufacturing step, where the insert includes a plurality of discrete grid systems, each including a plurality of openings through the insert. Lin, at most, only discloses one lattice structure, but there are no openings that extend through this lattice layer. To the extent that Kendall discloses a plurality of grid systems, the grid systems are adjacent to or contiguous with each other, and thus not *discrete*, as recited in new independent claim 35.

New claim 36 depends from claim 13 and is patentable for at least the same reasons as claim 13. Furthermore, the recitation that the "first energy return grid system is discrete from said second energy return grid system" is neither taught or suggested by Kendall or Lin.

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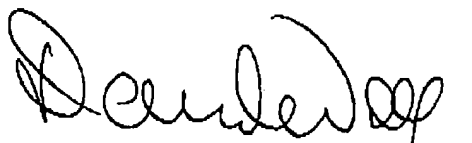
**CONCLUSION**

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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